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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/760,260	01/21/2004	Kia Silverbrook	WAL16US	1041

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SILVERBROOK RESEARCH PTY LTD
393 DARLING STREET
BALMAIN, 2041
AUSTRALIA

EXAMINER

NGUYEN, LAM S

ART UNIT	PAPER NUMBER
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2853

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/05/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/760,260

Applicant(s)

SILVERBROOK ET AL.

Examiner

LAM S. NGUYEN

Art Unit

2853

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) 2-4, 6-11, 14-16, 19, 20, 32-36, 43 and 48 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 5, 12, 13, 17, 18, 21-31, 37-42, 44, 45 and 47-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 10/12/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

In response to the restriction requirement, the applicant elected claims 1, 5, 12, 13, 17, 18, 21-31, 37-42, 44, 45, and 47-49 for further examination.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claim 1 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 42 of U.S. Patent No. 6944970. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 42 of U.S. Patent No. 6944970 anticipates the claim in the present application.
2. Claim 1 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 42 of U.S. Patent No. 6920704. Although the conflicting claims

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are not identical, they are not patentably distinct from each other because claim 42 of U.S. Patent No. 6920704 anticipates the claim in the present application.

3. Claim 1 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 44 of U.S. Patent No. 7186042. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 44 of U.S. Patent No. 7186042 anticipates the claim in the present application.

4. Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over each of claim 43 of copending Application No. 10/760228, claim 43 of copending Application No. 10/760225, claim 44 of copending Application No. 10/760240, claim 45 of copending Application No. 10/760226, claim 44 of copending Application No. 10/760224, claim 46 of copending Application No. 10/760199, claim 44 of copending Application No. 10/760193, claim 46 of copending Application No. 10/760269, claim 45 of copending Application No. 10/760266, claim 45 of copending Application No. 10/760230, claim 45 of copending Application No. 10/760215, claim 45 of copending Application No. 10/760230, claim 45 of copending Application No. 10/760241, claim 45 of copending Application No. 10/760230, claim 45 of copending Application No. 10/760256, or claim 45 of copending Application No. 10/760214. Although the conflicting claims are not identical, they are not patentably distinct from each other because each of the identified claims above anticipates the current claimed invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 17, 31, 37-38, 41-42, 44-45, 47-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin (US 2002/0171692 A1) in view of Nozawa (US 5701147).

Regarding to claims 1, 31, 37-38, 41-42, 44-45, 47-49:

Martin discloses a printer for producing rolls of wallpaper, comprising:

a housing (*FIG. 2, element 18*) in which is located a media path which extends from a blank media intake to a wallpaper exit slot (*FIG. 2, elements 24 and 26*);

a multi-color removable printhead (*FIG. 2, element 20*) located in the housing;

the printhead being supplied by separate ink reservoirs (*FIG. 2, element 22*), the reservoirs connected to the printhead by a an ink supply harness, there being a disconnect coupling between the reservoirs and the printhead;

one or more input devices (*FIG. 2, element 30, 32*) for capturing operator instructions;

a processor which accepts operator inputs which are used to configure the printer for producing a particular roll (*FIG. 2, element 38*).

Martin however is silent wherein the printhead is roll width.

Nozawa discloses a printing apparatus comprising a printhead (*FIG. 9, element 204*) for forming images across a moving printing medium (*FIG. 9, element 203*), wherein the printheads

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having a width about the same as one of the printing medium (full width) and located across the moving path of printing medium.

Therefore, it would have been obvious for one having ordinary skill in the art at the time invention was made to modify Martin's printhead to be full width printhead as disclosed by Nozawa. The motivation for doing so would have been to be able to print the entire width of the printing medium without scanning the printhead to gain printing speed as taught by Nozawa (*column 1, lines 30-39; column 3, lines 57-62*).

- **Martin also discloses the following claimed invention:**

Regarding to claim 17: wherein the path comprises a generally straight path which is self threading (*FIG. 2*).

Regarding to claims 31, 37, 41: the winding area adapted to removably retain a core and wind on it, wallpaper produced by the printer (*FIG. 2, element 24, 26*), and the length and design of the roll are determined by the operator inputs (*paragraph [0010]*).

Regarding to claim 42: running the printer according to the data; printing a single roll of wallpaper, on demand, according to a selected pattern and configuration (*paragraphs [0009]-[0010]*), and changing the pattern according to a new datum from an operator and then printing a new roll onto the same web (*paragraph [0010]: A user loads a blank roll of wallpaper in the printer and inputs one or more personal images that is/are printed on the blank roll. It means that for each customer or order a blank roll is loaded and printed with a new pattern (design/image). In addition, at certain point of time, when the length of the current roll is not enough for a new order, then a new roll is loaded to the same web for printing images with the new order*).

Regarding to claim 48: a motor within the cabinet for advancing the media web out of the media cartridge and one or more motors adapted to urge the media along the path and out of the slot (*FIG. 2: The corresponding motor or motors drive(s) the supply roll, the take-up roll, or the drive roller*).

Regarding to claims 38, 39, 40, 42, 44, and 49: The claims even though depend on claim 1 which is an apparatus claim, but cite a method of using the apparatus. The claims thus do not contribute to the physical structure of the apparatus. As a result, the claims are considered but not given patentable weight.

6. Claims 39-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin (US 2002/0171692 A1) in view of Nozawa (US 5701147), as applied to claim 1, and further in view of Goldstein (US 2002/0069078 A1).

Martin, as modified, discloses the claimed invention as discussed above but is silent about charging a customer for the roll or obtaining/attempting to obtain a fee from a franchisee.

Goldstein discloses a system for creating custom wallpaper including a program to charge and obtain fee from customers ordered printed wallpaper rolls (*FIG. 2, steps 208, 210, 212, 214*).

Therefore, it would have been obvious for one having ordinary skill in the art at the time invention was made to modify Martin's apparatus, as modified, to include means for charging and obtaining fee from a customer as disclosed by Goldstein et al. The motivation for doing so would have been to allow an operator/customer to purchase created custom wallpaper as taught by Goldstein (*paragraphs [0043]-[0046]*).

7. Claims 21-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin (US 2002/0171692 A1) in view of Nozawa (US 5701147), as applied to claim 1, and further in view of Silverbrook (US 2002/0158924 A1).

Martin, as modified, discloses the claimed invention as discussed above except wherein the blank media is printed by the printhead at a rate exceeding 0.2 square meters per second (7750 square feed per hour), wherein the printhead has more than 250,000 nozzles, and wherein the printhead prints ink drops with a volume of less than 1.5 picoliters.

Silverbrook discloses an ink jet printing apparatus comprising an ink jet printhead for ejecting ink drops on a printing medium to form images, wherein the printhead has more than 250,000 nozzles (*paragraph [0099]*), ejects ink drops with a volume of less than 1.5 picoliters (*paragraph [0101]*), and prints the media at a rate exceeding 0.2 square meters per second (7750 square feed per hour) (*paragraph [0102]*).

Therefore, it would have been obvious for one having ordinary skill in the art at the time invention was made to modify the printhead in Martin's printing apparatus, as modified, to have a large number of nozzles and eject small volume ink drops as disclosed by Silverbrook. The motivation for doing so would have been to allow the printhead to print at high rate such as 21.6 billion drops/second to provide thirty-five thousand square feet per hour as taught by (*paragraph [0102]*).

8. Claims 12-13 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin (US 2002/0171692 A1) in view of Nozawa (US 5701147), as applied to claim 1, and further in view of Rasmussen et al. (US 6536894).

Martin, as modified, discloses the claimed invention as discussed above except wherein the path further comprises a flat platen pre-heater located before the printhead in the path and below a moving web, and further comprising an air supply and a tube for bringing a supply of air to the printhead which supply prevents media from contacting the printhead.

Rasmussen et al. discloses a printing system including a printhead (*FIG. 2A, element 14*) for forming images on a printing medium moving on a media path, a flat platen pre-heater (*FIG. 2A, element 201*) located before the printhead and below a moving web (*FIG. 2A, element 32*), and an air supply and a tube for bringing a supply of air to the printhead which supply prevents media from contacting the printhead (*FIGs. 1, 2A; element 37*).

Therefore, it would have been obvious for one having ordinary skill in the art at the time invention was made to modify Marin's printing apparatus, as modified, to include a pre-heater located before the printhead as disclosed by Rasmussen et al. The motivation for doing so would have been to provide mechanism for drying and flattening a sheet prior to ink jet printing to reduce inherent moisture in order to improve ink jet print quality as taught by Rasmussen et al. (*Abstract*).

9. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martin (US 2002/0171692 A1) in view of Nozawa (US 5701147), as applied to claim 1, and further in view of Austin et al. (US 5488223).

Martin, as modified, discloses the claimed invention as discussed above except a bar code scanner which communicates with the processor and through which data is input.

Austin et al. discloses a printing system including a bar code scanner (*Abstract; FIG. 2A, element 114*) communicating with a processor (*FIG. 2A, element 120*), wherein the bar code scanner is used for input data (data entry) (*Abstract*).

Therefore, it would have been obvious for one having ordinary skill in the art at the time invention was made to modify Martin's printing apparatus to include a bar code scanner as disclosed by Austin et al. The motivation for doing so would have been to allow operators to input/entry desired data as taught by Austin et al. (*Abstract*).

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LAM S. NGUYEN whose telephone number is (571)272-2151. The examiner can normally be reached on 7:00AM - 3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, STEPHEN D. MEIER can be reached on (571)272-2149. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



LAM SON NGUYEN